

above the focal point of a laser beam (Towler, page 10, line 28 to page 11, line 4).

Reconsideration and withdrawal of the rejection of claim 1 is respectfully requested.

Claims 2-4, 7-8 and 15 depend from claim 1 and are allowable therewith for at least the reasons set forth above, without regard to further patentable limitations contained therein. Reconsideration and withdrawal of the rejection of claims 2-4, 7-8 and 15 is respectfully requested.

### 35 U.S.C. § 103 Rejection

Claims 5-6 and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Canadian Patent Application No. 2,205,284 (Towler) and U.S. Patent No. 5,698,283 (Yamasaki). Claim 16 is rejected under 35 U.S.C. § 103(a) as unpatentable over Towler in view of German patent publication DE 44 24 686 A1 ('686 reference). The rejections should be withdrawn because a *prima facie* case of obviousness has not been made by the Examiner.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation for combining or modifying the references. Second, there must be a reasonable expectation of success. Third, the prior art must teach or suggest all of the claim limitations. *See* MPEP § 2143.

The Office Action fails to meet all of the required criteria. The Office Action states that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified [Towler's] cutter by providing the oscillating cutter/blade as taught by Yamasaki in order to cut the support layer made of thermoplastic elastomer material." Similarly, the Office action states that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified [Towler's] device by providing the end having a semicircular shape as taught by foreign patent '686 in order to prevent the tearing action which occurs along the breaking line from being extended beyond the end of the breaking line." However, the Office Action does not provide any reason why one of ordinary skill in the art would have been motivated to make such modifications. Thus, a *prima facie* case of obviousness has not been made, and the rejections should be withdrawn.

At column 5, lines 48-50, Yamasaki discloses a cutting element that takes the form of "a working hone 22 of a supersonic welder." The cutting element of Yamasaki may be "a

heated cutter or high frequency cutter.” (Yamasaki, col. 6, lines 11-12.) There is no reasonable expectation of success that would motivate one of ordinary skill in the art to replace the scoring laser of Trowler described above—which controls cutting depth using a laser power intensity level or a laser beam focal point distance—with an instrument of the type found in Yamasaki—which is a relatively large and blunt heated cutting or welding tool. Moreover, such a combination would impermissibly change the principal of operation of Towler. *See* MPEP § 2143.01. Thus, the rejection of claims 5-6 and 9 should be withdrawn.

In Figure 1, the ‘686 reference discloses a breaking line with a semicircular end shape. There is no motivation to induce a person of ordinary skill to consider combining the semicircular end shape of the ‘686 reference—which prevents the tearing action of the breaking line from extending beyond the breaking line—with the process and apparatus of Towler—the objective of which is to provide precision laser scoring of workpieces of varying thickness. “Although a prior art device ‘may be capable of being modified to run the way [the claimed invention] is claimed, there must be a suggestion or motivation in the reference to do so.” *See* MPEP § 2143.01, citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1992). Thus, the rejection of claim 16 should be withdrawn.

The Federal Circuit recently emphasized the importance of evidencing the requisite motivation to combine references when rejecting claims based upon obviousness. In *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), the court stated that the factual inquiry whether to combine references must be thorough and searching.

[The inquiry] must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

277 F.3d at 1343, 61 USPQ2d at 1433.

In the present case, the examiner has failed to make the requisite showing, as articulated in *Lee* and its predecessors, of a motivation to combine the cited references. Accordingly, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness.

In addition, with regard to the third criteria, the rejections of claims 5-6, 9 and 16 should be withdrawn because the cited references do not disclose a cutter having a blade. By way of background, Applicants direct the Examiner's attention to the present application, which discloses a method of forming tear lines in an airbag cover 1 using a cutter 11 that has a blade. In particular, use of a scalpel-type blade "makes it possible to cut the cover without inducing thermal stress, allowing cutting of coated or leather-clad airbag covers." (Specification at page 5, para. 24.) Further, the blade geometry is critical to obtaining the precise cut depth. In contrast, Towler discloses only a scoring laser 52, 84. Yamasaki discloses a cutting element that takes the form of "a working hone 22 of a supersonic welder" (Yamasaki, col. 5, lines 48-50) or "a working blade C1 of a supersonic welder" (Yamasaki, col. 9, lines 15-21). The cutting element of Yamasaki may be "a heated cutter or high frequency cutter." (Yamasaki, col. 6, lines 11-12.) There is a fundamental difference between a blade having a sharp edge, as in the present application, and a heated instrument having a relatively blunt configuration such as found in Yamasaki or a source of heat such as a laser found in Towler. The rejections of claims 5-6, 9 and 16 should be withdrawn because the references do not teach all of the claim limitations of the present invention.

Accordingly, because amended claim 1 now includes the features recited in original claim 6, claims 1-5, 7-9 and 15-16 are patentable over the cited references for at least the reasons state above.

### Conclusion

In view of the foregoing amendments and remarks, Applicants believe that the application is now in condition for allowance. An early Notice of Allowance is respectfully requested. If there are any questions regarding the prosecution of this application, the Examiner is invited to contact the undersigned attorney at the phone number listed below.

Respectfully submitted,

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Version with Markings to Show Changes Made

In the Claims

1. (Amended) A method of forming a weakening area in an airbag cover having a support layer and a decorative layer over the support layer, comprising the steps of:
  - providing a cutting support that supports the airbag;
  - providing a cutter **having a blade**;
  - placing the airbag cover with the decorative layer facing down on the support; and
  - cutting a tear line of a predetermined pattern through the support layer and into the decorative layer with the cutter while controlling the depth of cut relative to the support to precisely control the residual thickness of the tear line and to prevent the cutter from penetrating through the decorative layer.